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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,577	02/12/2001	Irene E. Kochevar	10284-018001	9723

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EXAMINER

BARRETT, THOMAS C

ART UNIT PAPER NUMBER

3738

DATE MAILED: 12/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/781,577

Applicant(s)

KOCHEVAR ET AL.

Examiner

Thomas C. Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**REQUEST FOR CONTINUED EXAMINATION**

The request filed on November 17, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/781577 is acceptable and a RCE has been established. An action on the RCE follows.

***Response to Arguments***

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

***Oath/Declaration***

The declaration filed on April 10, 2003 under 37 CFR 1.131 is sufficient to overcome the 102(e) rejection of the Murphy and Melke references and correct the declaration.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As noted in MPEP 2173.05(u): "If the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second

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paragraph." LASIK is a trademark and is used in claims 14 and 20 as a limitation to identify or describe a particular product, Laser-Assisted *In Situ* Keratomileusis.

### ***Claim Rejections - 35 USC § 102***

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-14, 17-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Khadem et al. (5,552,452) as cited in applicant's IDS. Khadem et al. discloses a method for adhering tissue comprising: contacting a tissue with a photosensitizer, creating a tissue-photosensitizer mixture, applying electromagnetic energy without more than a 1 degree rise in temperature (col. 3, line 67- col. 4, line 3), and creating a tissue seal without contacting the tissue with an exogenous cross-linkable substrate (col. 7, lines 18-30). The method may comprise the use of Rose Bengal and energy applied at 600-670 nm (Table 1) or a thiazine (col. 4, line 64- col. 5, line 3), and can be used for refractive surgery (col. 8, lines 3-8). The methods can be used on humans and in vivo or ex vivo (col. 15, lines 39-47).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khadem et al. (5,552,452). Khadem et al. discloses a method for adhering tissue comprising: contacting a tissue with a photosensitizer, creating a tissue-photosensitizer mixture, applying electromagnetic energy without more than a 1 degree rise in temperature however Khadem et al. fails to disclose specific W/cm and J/cm ranges. MPEP 2144.05 states:

## **II. OPTIMIZATION OF RANGES**

### **A. Optimization Within Prior Art Conditions or Through Routine Experimentation**

Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."

The general conditions of the claims are disclosed in Khadem et al. Khadem et al. discloses adhering tissue using a laser at wavelengths greater than 488 nm and a photosensitizer under conditions that minimize tissue damage (col. 2, lines 55-67). Lasers are well known in the art to have controllable energy doses and irradiances, such as the commercial ones admitted to by the Applicant (pp 15-16). The optimum ranges of energy doses and irradiances can easily be found through routine experimentation. It would have been obvious to one of ordinary skill in the art to combine the teaching of routine experimentation to determine the optimum ranges of energy doses and irradiances, to a method for adhering tissue as per Khadem et al., in order to minimize tissue damage.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3580 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9306.

A handwritten signature in black ink, appearing to read 'Thomas Barrett', with a stylized flourish at the end.

Thomas Barrett  
December 1, 2003